

Exhibit 4

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS**

<p>NEUTRAL TANDEM, INC.,</p> <p style="text-align: center;">Plaintiff,</p> <p style="text-align: center;">v.</p> <p>PEERLESS NETWORK, INC., PEERLESS NETWORK of ILLINOIS, LLC, and JOHN BARNICLE,</p> <p style="text-align: center;">Defendants.</p> <hr/> <p>PEERLESS NETWORK, INC., PEERLESS NETWORK of ILLINOIS, LLC, and JOHN BARNICLE,</p> <p style="text-align: center;">Counterclaim Plaintiffs,</p> <p style="text-align: center;">v.</p> <p>NEUTRAL TANDEM, INC.,</p> <p style="text-align: center;">Counterclaim Defendant.</p>	<p>No. 08-CV-3402</p> <p>Judge John W. Darrah</p> <p><u>L</u></p>
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DECLARATION OF THE HONORABLE GERALD J. MOSSINGHOFF

INTRODUCTION

1. This declaration is provided in support of plaintiff's' opposition to the Defendant's request for a stay in this action pending the outcome of an *inter partes* reexamination by the U.S. Patent and Trademark Office ("USPTO") of the U.S. Patent 7,123, 708 (the "708 Patent") subject to this action.

2. From 1981 through 1985, I served as the Assistant Secretary of Commerce and the Commissioner of Patents and Trademarks at the United States Patent & Trademark Office

(USPTO). From 2000-2008, I served three terms on the Patent Public Advisory Committee, established pursuant to P.L. 106-113, among other things, to advise the Under Secretary of Commerce on the policies, goals and performance of the USPTO. Since January 1997, I have engaged in the private practice of intellectual property law as Senior Counsel with the firm of Oblon, Spivak, McClelland, Maier & Neustadt, L.L.P., 1940 Duke Street, Alexandria, Virginia 22314. In addition, I currently teach intellectual property law at the George Washington University School of Law. In 2007 I was inducted into the Intellectual Property Hall of Fame.

NEWLY INITIATED *INTER PARTES* REEXAMINATION

3. The USPTO grants 96% of requests for *inter partes* reexamination. (Exhibit A at entry 5a). The high grant rate of *inter partes* reexamination requests is due to the liberal standard applied in considering the submitted art, as well as the fact that the USPTO only considers evidence and argument put forth by the party seeking *inter partes* reexamination (typically, as in this case, a defendant in a patent infringement lawsuit), when deciding whether to grant the request. The grant of patent reexamination, whether *ex parte* or *inter partes* is based upon a determination that the prior art submitted along with the request would have been deemed “important” to a reasonable examiner, thereby presenting a substantial new question of patentability (SNQ). Because this standard is different than a *prima facie* showing of unpatentability, virtually every request for *inter partes* reexamination (i.e., 96%) is granted. As such, the mere grant by the examiner of a request for reexamination is not necessarily probative of unpatentability, because the reexamination proceeding is still incomplete and based solely on the evidence provided by the party seeking reexamination.

4. At present, no further action will occur in the reexamination of the '708 Patent unless the plaintiff is required to respond to the non-final rejection of March 26, 2010. Since the plaintiff has sought suspension of the '708 Reexamination, based upon the defendants' significant delay in initiating the proceeding relative to the advanced stage of this litigation, there exists some uncertainty as to whether or not the proceeding will continue at all. In the past, the USPTO has found that an advanced stage of litigation is "good cause" enough to suspend a newly initiated *inter partes* reexamination proceeding.¹ This is because a final determination with respect to validity in a related district court is controlling on the USPTO in *inter partes* reexamination. Accordingly, good cause may be found here as the USPTO will be able to conserve resources on a likely wasteful exercise (in view of the pending trial).

CURRENT *INTER PARTES* REEXAMINATION TIMELINE

5. Tentatively, the plaintiff's response to the non-final action office action dated March 26, 2010 is due to be filed on July 26, 2010. If the reexamination is not suspended in the interim, and if the plaintiff does not request a further extension of time to allow the USPTO to decide the outstanding petition for suspension, the defendant would be required to submit their rebuttal comments by August 26, 2010. It is difficult to gauge when the examiner would consider the plaintiff and defendant submissions, however, based on published USPTO statistics, even this consideration of plaintiff's initial submission to the USPTO will not likely occur until early 2011.

6. Should the examiner be required to consider the submissions of both parties in early 2011, the reexamination proceeding will carry on from the first page of flow charts

¹ *Sony Computer Entertainment America Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va 2006)

attached hereto, until such time as a final determination is issued in this litigation (Exhibit B).²

However, in the event a final determination of validity is reached in the litigation pending in this Court prior to conclusion of the reexamination proceedings at the USPTO,³ the USPTO must vacate the reexamination by operation of law.

7. On the other hand, if the litigation is stayed between the parties, the reexamination process will continue on through the next two pages of flow charts illustrating the necessary USPTO proceedings. Once the complete procedural process internal to the USPTO is completed, (Exhibit B) including the repeating of certain procedures as required by reopening of prosecution, changed positions of the examiner on appeal, new non-final rejections, appeals remanded by the BPAI, etc, appeal may be finally taken to the CAFC.

8. Attached Exhibit C (Timing of Proceedings) notes an average time to termination of an *inter partes* reexamination (Notice of Intent to Issue a Reexamination Certificate (NIRC)) as being 34.6 months. However, this average time is misleading as termination of the proceeding is commonly caused by operation of law rather than a true, contested conclusion to the proceeding. Only 152 *inter partes* reexaminations have been concluded in the 11 or so years they have been in existence. Of these concluded proceedings, not one single case has been contested through to a CAFC final judgment. Indeed, only one *inter partes* reexamination has even reached the CAFC in the past 11 years, namely, *Cooper Cameron v. SAFOCO Inc.*, Nos. 2009-1435-1459 (Federal Circuit) *inter partes* reexamination Nos. 95/000,015 and 95/000,017. The *Cooper* reexaminations were initiated by the USPTO in **May 2003**. Upon completion of prosecution and appeals within the USPTO (i.e., Exhibit B), the proceedings finally reached the

² Graphic illustrations of the *inter partes* reexamination process – Procedure Prior to Appeal, Appeal Procedure, and Procedures Following Board Decision for reexaminations commenced after November 2, 2002, from the current edition of the USPTO's Manual of Patent Examining Procedure.

³ That is a final determination of this court (not appealed), final determination of the CAFC, or defendant settlement stipulating to validity.

CAFC in **June of 2009**. Yet, prior to a decision by the CAFC the parties settled their dispute and withdrew all appeals.

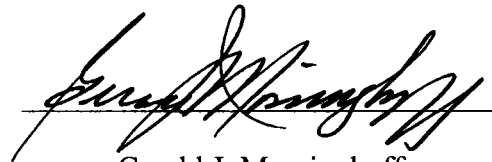
9. Accordingly, the 34.6 month pendency figure of Exhibit C reflects an incomplete view of *inter partes* reexamination as not a single one of the 152 concluded *inter partes* reexamination has been contested to conclusion; that is to say, only a single case has managed to traverse the flow charts of Exhibit B to even get to the CAFC. Thus, the 34.6 month figure is artificially depressed by a statistically insignificant sample size, and *inter partes* reexaminations that are vacated by the USPTO by operation of law.

10. A truer representation of the time necessary to traverse the full length of the flow charts of Exhibit D is clarified by the presentation materials of Chief Judge Fleming of the Board of Patent Appeals and Interferences (BPAI) provided to the ABA Intellectual Property Law Section on April 9, 2010. As noted at slide two of his recent presentation, Chief Judge Fleming identifies the pendency from initial filing of an *inter partes* reexamination to BPAI appeal is 64.3 months, roughly double the 34.6 figure. (Exhibit D at page 2). Chief Judge Fleming's statistics do not account for appeal pendency to the CAFC, which can only proceed after all BPAI processing is complete.

11. There are currently over 15,000 appeals pending at the USPTO Board of Patent Appeals and Interferences ("BPAI"), 14 of which resulted in *inter partes* reexamination decisions in 2010. The backlog in appeals pending before the BPAI increased from 2,987 at the end of 2009 to the current number of 15,424. The USPTO data regarding appeals to the BPAI in 2010 is shown in Exhibit E to this declaration. As the BPAI backlog continues to grow, the 64.3 month duration to an appealable USPTO decision for *inter partes* reexamination is likely to worsen going forward.

I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge and belief.

Executed this 7th day of June, 2010 in Alexandria, Virginia.



Gerald J. Mossinghoff

Declaration of the
Honorable Gerald J. Mossinghoff

Exhibit A



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
 United States Patent and Trademark Office
 P.O. Box 1450
 Alexandria, VA 22313-1450
 www.uspto.gov

Inter Partes Reexamination Filing Data – March 31, 2010

1. Total requests filed since start of *inter partes* reexam on 11/29/99.....860¹
2. Number of filings by discipline

a. Chemical Operation	167	20%
b. Electrical Operation	416	48%
c. Mechanical Operation	265	31%
d. Design Patents	12	1%
3. Annual Reexam Filings

<u>Fiscal Yr.</u>	<u>No.</u>	<u>Fiscal Yr.</u>	<u>No.</u>	<u>Fiscal Yr.</u>	<u>No.</u>	<u>Fiscal Yr.</u>	<u>No.</u>
2000	0	2003	21	2006	70	2009	258
2001	1	2004	27	2007	126	2010YTD	126
2002	4	2005	59	2008	168		
4. Number known to be in litigation.....600.....70%
5. Decisions on requests 763
 - a. No. granted 731 96%
 - (1) By examiner 730
 - (2) By Director (on petition) 1
 - b. No. not granted 32 4%
 - (1) By examiner 28
 - (2) Reexam vacated 4
6. Overall reexamination pendency (Filing date to certificate issue date)
 - a. Average pendency 36.5 (mos.)
 - b. Median pendency 32.0 (mos.)
7. Total *inter partes* reexamination certificates issued (1999 - present) 152
 - a. Certificates with all claims confirmed 12 8%
 - b. Certificates with all claims canceled (or disclaimed) 76 50%
 - c. Certificates with claims changes 64 42%

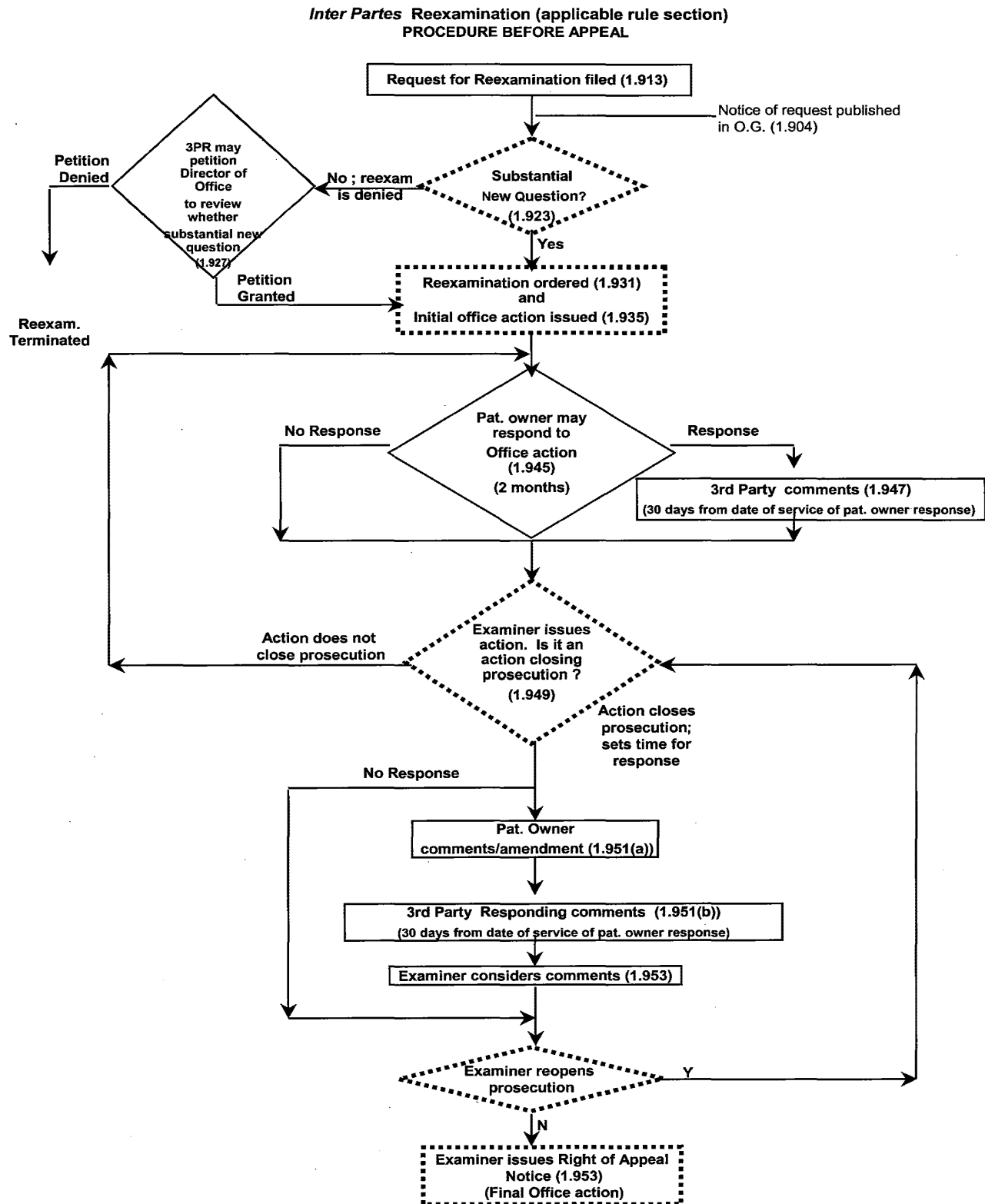
¹Of the requests received in FY 2010, 7 requests have not yet been accorded a filing date, and 10 requests have had preprocessing terminated, for failure to comply with the requirements of 37 CFR 1.915. See Clarification of Filing Date Requirements for *Ex Parte* and *Inter Partes* Reexamination Proceedings, Final Rule, 71 Fed. Reg. 44219 (August 4, 2006).

Declaration of the
Honorable Gerald J. Mossinghoff

Exhibit B

2601.01

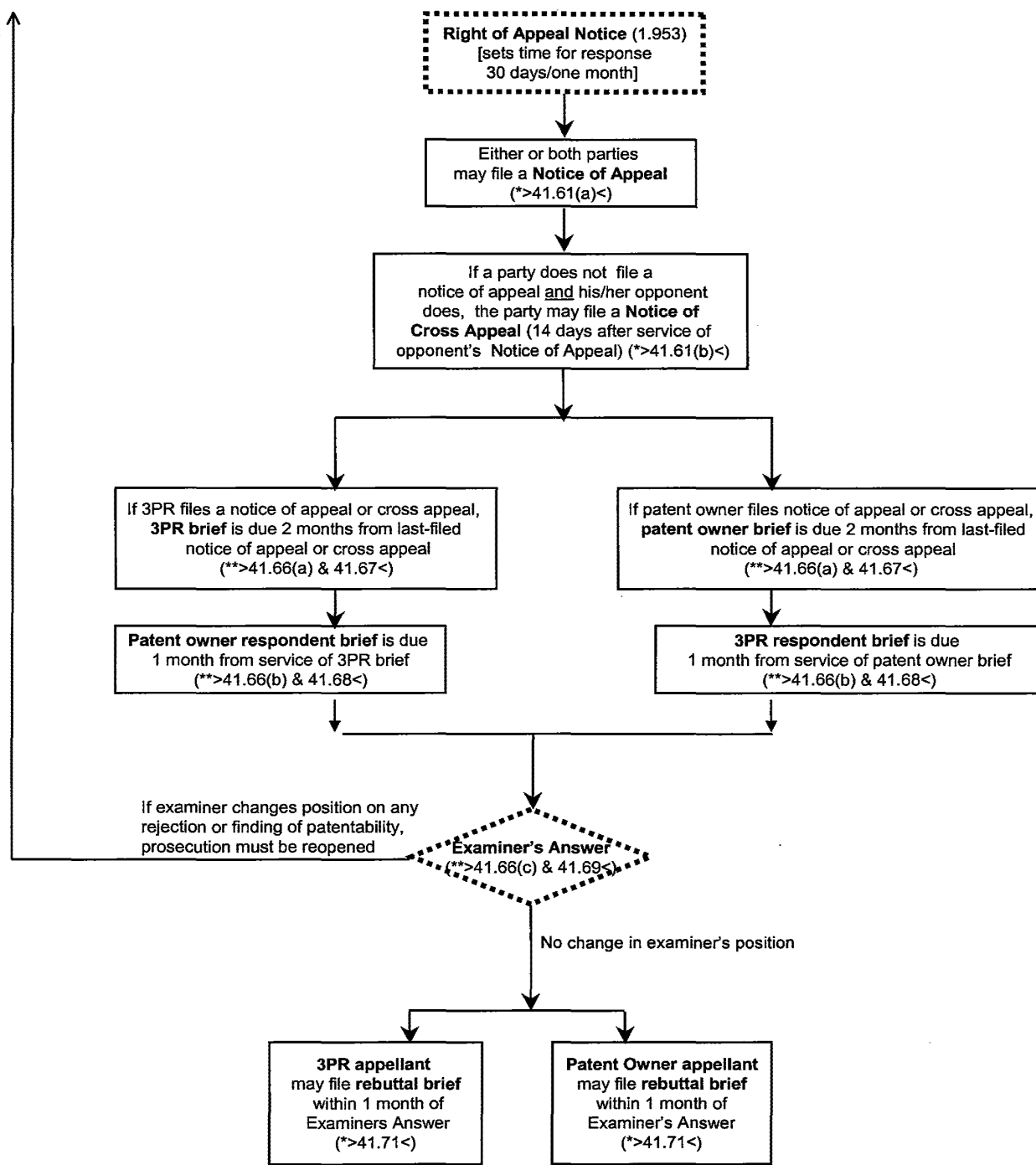
MANUAL OF PATENT EXAMINING PROCEDURE



OPTIONAL INTER PARTES REEXAMINATION

2601.01

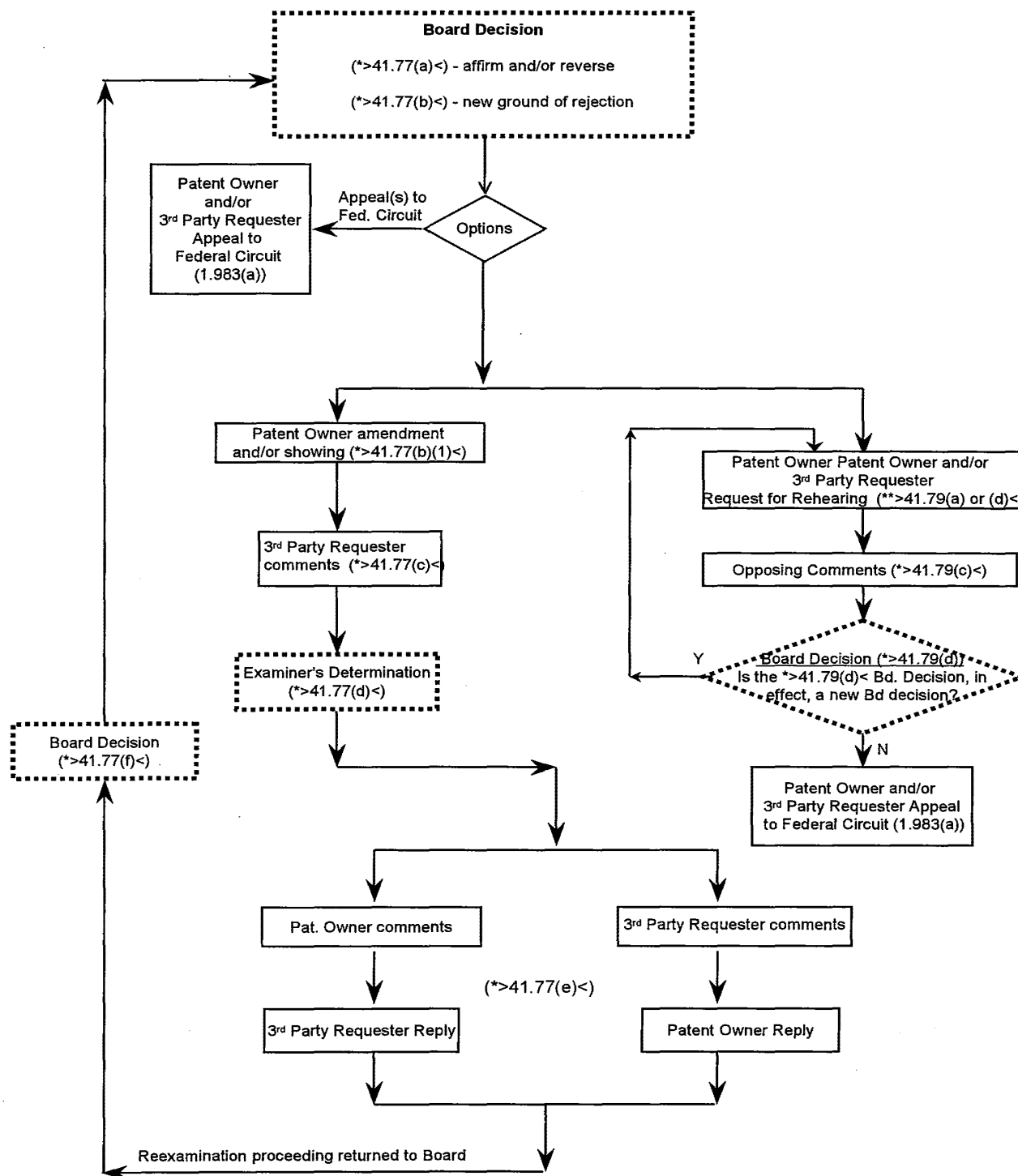
Inter Partes Reexamination (applicable rule section)
APPEAL PROCEDURE
Single Third Party Requester



OPTIONAL INTER PARTES REEXAMINATION

2601.01

Inter Partes Reexamination (applicable rule section)
**Procedure Following Board Decision for Reexaminations
Commenced On or After November 2, 2002**



Declaration of the
Honorable Gerald J. Mossinghoff

Exhibit C

Quarter ending 3/31/10

Reexaminations - FY 2010



Pending Reexaminations

	Quarter 1	Quarter 2	Quarter 3	Quarter 4
Preprocessing	87	83		
Awaiting Order/Denial	96	109		
Between Order and First Action on the Merits	343	279		
Between FAOM and NIRC	1345	1395		
Between NIRC and Publication of Certificate	162	197		
Total	2033	2063		

Volume of Proceedings

	YTD Through Quarter 1	YTD Through Quarter 2	YTD Through Quarter 3	YTD Through Quarter 4
Filings	242	470		
Ex Parte	168	344		
Inter Partes	74	126		
Orders Granting Reexamination	205	396		
Ex Parte Orders	153	282		
Inter Partes Orders	52	114		
Denials	10	23		
Ex Parte Denials	10	22		
Inter Partes Denials		1		
First Actions on the Merits	186	451		
Ex Parte FAOMs	122	319		
Inter Partes FAOMs	64	132		
Notices of Intent to Issue a Reexamination Certificate	183	389		
Ex Parte NIRC	165	351		
Inter Partes NIRC	18	38		
Reexamination Certificates	254	445		
Ex Parte Certificates	224	395		
Inter Partes Certificates	30	50		

Timing of proceedings

	Quarter 1	Quarter 2	Quarter 3	Quarter 4
Average Months from Filing to Order	1.9	1.9		
Average Months to Ex Parte Order	1.9	1.8		
Average Months to Inter Partes Order	2.2	2.1		
Average Months from Filing to Denial	2.0	1.9		
Average Months to Ex Parte Denial	2.0	2.0		
Average Months to Inter Partes Denial		1.6		
Average Months from Filing to FAOM	6.5	6.9		
Average Months to Ex Parte FAOM	7.6	7.8		
Average Months to Inter Partes FAOM	4.4	4.2		
Average Months from Filing to NIRC	24.1	24.1		
Average Months to Ex Parte NIRC	23.0	23.8		
Average Months to Inter Partes NIRC	34.6	26.9		
Average Months from Filing to Certificate	31.8	27.6		
Average Months to Ex Parte Certificate	31.1	26.5		
Average Months to Inter Partes Certificate	37.3	37.3		

Source: Filings from ex parte and inter partes historical statistics.

Pendency, First action, NIRC ("Notice of Intent to Issue a Reexamination Certificate") and Certificate data from PALM.

Note: This data is recorded by reexamination control number. Where proceedings are merged, the merged proceeding will appear as multiple instances. For this reason the certificate count will not match the number of individual reexamination certificates published in the Official Gazette.

Reexaminations - FY 2009



Pending Reexaminations

	Quarter 1	Quarter 2	Quarter 3	Quarter 4
Preprocessing	42	77	56	89
Awaiting Order/Denial	127	110	127	101
Between Order and First Action on the Merits	438	373	339	323
Between FAOM and NIRC	1336	1356	1373	1349
Between NIRC and Publication of Certificate	171	224	207	258
Total	2114	2140	2102	2120

Volume of Proceedings

	YTD Through Quarter 1	YTD Through Quarter 2	YTD Through Quarter 3	YTD Through Quarter 4
Filings	222	441	676	916
Ex Parte	154	308	481	658
Inter Partes	68	133	195	258
Orders Granting Reexamination	191	392	583	794
Ex Parte Orders	153	288	427	576
Inter Partes Orders	38	104	156	218
Denials	17	27	41	51
Ex Parte Denials	10	18	29	38
Inter Partes Denials	7	9	12	13
First Actions on the Merits	195	449	686	910
Ex Parte FAOMs	154	332	519	701
Inter Partes FAOMs	41	117	167	209
Notices of Intent to Issue a Reexamination Certificate	137	372	581	822
Ex Parte NIRC	130	338	521	735
Inter Partes NIRC	7	34	60	87
Reexamination Certificates	171	346	571	797
Ex Parte Certificates	160	324	527	724
Inter Partes Certificates	11	22	44	73

Timing of proceedings

	Quarter 1	Quarter 2	Quarter 3	Quarter 4
Average Months from Filing to Order	2.0	1.8	1.8	1.9
Average Months to Ex Parte Order	1.9	1.7	1.7	1.8
Average Months to Inter Partes Order	2.3	2.1	1.9	2.1
Average Months from Filing to Denial	2.4	2.2	1.6	1.7
Average Months to Ex Parte Denial	2.1	2.3	1.7	1.8
Average Months to Inter Partes Denial	2.8	1.8	1.0	1.0
Average Months from Filing to FAOM	9.5	8.7	7.7	7.5
Average Months to Ex Parte FAOM	10.3	10.6	8.7	8.2
Average Months to Inter Partes FAOM	6.1	4.2	3.7	4.7
Average Months from Filing to NIRC	24.2	28.9	28.3	25.8
Average Months to Ex Parte NIRC	23.5	28.1	28.2	24.7
Average Months to Inter Partes NIRC	36.6	35.2	29.3	34.5
Average Months from Filing to Certificate	32.9	31.0	33.8	31.1
Average Months to Ex Parte Certificate	32.3	31.1	33.0	30.5
Average Months to Inter Partes Certificate	41.7	28.9	41.7	35.2

Source: Filings from ex parte and inter partes historical statistics.

Pendency, First action, NIRC ("Notice of Intent to Issue a Reexamination Certificate") and Certificate data from PALM.

Note: This data is recorded by reexamination control number. Where proceedings are merged, the merged proceeding will appear as multiple instances. For this reason the certificate count will not match the number of individual reexamination certificates published in the Official Gazette.

Reexaminations - FY 2008



Pending Reexaminations

	Quarter 1*	Quarter 2*	Quarter 3*	Quarter 4
Preprocessing				
Awaiting Order/Denial				
Between Order and First Action on the Merits				
Between FAOM and NIRC				
Between NIRC and Publication of Certificate				
Total				

Volume of Proceedings

	YTD Through Quarter 1*	YTD Through Quarter 2*	YTD Through Quarter 3*	YTD Through Quarter 4
Filings	210	412	615	848
Ex Parte	165	330	487	680
Inter Partes	45	82	128	168
Orders Granting Reexamination	185	372	579	768
Ex Parte Orders	153	305	468	626
Inter Partes Orders	32	67	111	142
Denials	7	20	41	48
Ex Parte Denials	5	13	33	40
Inter Partes Denials	2	7	8	8
First Actions on the Merits	182	400	613	895
Ex Parte FAOMs	157	334	506	752
Inter Partes FAOMs	25	66	107	143
Notices of Intent to Issue a Reexamination Certificate	138	249	377	504
Ex Parte NIRC	131	234	357	471
Inter Partes NIRC	7	15	20	33
Reexamination Certificates	175	279	408	597
Ex Parte Certificates	174	273	392	575
Inter Partes Certificates	1	6	16	22

Timing of proceedings

	Quarter 1*	Quarter 2*	Quarter 3*	Quarter 4
Average Months from Filing to Order	2.0	2.0	1.8	1.9
Average Months to Ex Parte Order	1.9	1.9	1.8	1.8
Average Months to Inter Partes Order	2.3	2.3	2.1	2.2
Average Months from Filing to Denial	2.2	2.3	2.5	1.6
Average Months to Ex Parte Denial	2.1	2.1	2.5	1.6
Average Months to Inter Partes Denial	2.7	2.8	1.9	
Average Months from Filing to FAOM	10.8	10.9	11.2	11.3
Average Months to Ex Parte FAOM	12.0	12.2	12.5	12.1
Average Months to Inter Partes FAOM	3.5	5.1	5.6	6.3
Average Months from Filing to NIRC	24.2	26.4	25.5	26.3
Average Months to Ex Parte NIRC	23.5	26.3	25.4	25.2
Average Months to Inter Partes NIRC	36.6	27.5	28.2	38.5
Average Months from Filing to Certificate	32.9	31.6	37.6	31.8
Average Months to Ex Parte Certificate	32.9	31.3	38.0	31.7
Average Months to Inter Partes Certificate	27.2	38.3	32.7	36.0

Source: Filings from ex parte and inter partes historical statistics.

Pendency, First action, NIRC ("Notice of Intent to Issue a Reexamination Certificate") and Certificate data from PALM.

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*Prior to the fourth quarter of FY 2008, PALM data was retrieved as of April 2009. Starting in the fourth quarter of 2008, data is from the end of the respective quarter.

Reexaminations - FY 2007



Pending Reexaminations

	Quarter 1	Quarter 2	Quarter 3	Quarter 4*
Preprocessing				
Awaiting Order/Denial				
Between Order and First Action on the Merits				
Between FAOM and NIRC				
Between NIRC and Publication of Certificate				
Total				

Volume of Proceedings

	YTD Through Quarter 1	YTD Through Quarter 2	YTD Through Quarter 3	YTD Through Quarter 4*
Filings				769
Ex Parte				643
Inter Partes				126
Orders Granting Reexamination				693
Ex Parte Orders				575
Inter Partes Orders				118
Denials				20
Ex Parte Denials				19
Inter Partes Denials				1
First Actions on the Merits				499
Ex Parte FAOMs				416
Inter Partes FAOMs				83
Notices of Intent to Issue a Reexamination Certificate				417
Ex Parte NIRC				409
Inter Partes NIRC				8
Reexamination Certificates				394
Ex Parte Certificates				391
Inter Partes Certificates				3

Timing of proceedings

	Quarter 1	Quarter 2	Quarter 3	Quarter 4*
Average Months from Filing to Order				2.0
Average Months to Ex Parte Order				2.0
Average Months to Inter Partes Order				2.4
Average Months from Filing to Denial				2.1
Average Months to Ex Parte Denial				2.1
Average Months to Inter Partes Denial				
Average Months from Filing to FAOM				12.3
Average Months to Ex Parte FAOM				14.2
Average Months to Inter Partes FAOM				3.2
Average Months from Filing to NIRC				28.3
Average Months to Ex Parte NIRC				28.3
Average Months to Inter Partes NIRC				27.7
Average Months from Filing to Certificate				39.6
Average Months to Ex Parte Certificate				39.9
Average Months to Inter Partes Certificate				27.1

Source: Filings from ex parte and inter partes historical statistics.

Pendency, First action, NIRC ("Notice of Intent to Issue a Reexamination Certificate") and Certificate data from PALM.

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Declaration of the
Honorable Gerald J. Mossinghoff

Exhibit D

Inter Partes Reexamination Appeals



Michael R. Fleming

Chief Administrative Patent Judge

Board of Patent Appeals and Interferences

United States Patent and Trademark Office

ABA-IPL

April 9, 2010



Inter Partes Reexamination Appeals

BPAI Pendency and Workload

	FY2008	FY2009	FY2010 (Mid-Year)
BPAI Pendency	8.1 months	7.0 months	11.8 months
Pendency of BPAI Decided Appeals from Date of Reexamination Filing at USPTO	50.9 months	67.3 months	64.3 months
Disposals	1	10	6
Docketed	4	15	13
Inventory	4	9	16



Inter Partes Reexamination Appeals

- Applicable Inter Partes Reexamination Rules
 - Examination procedure – 37 C.F.R. §§ 1.902-1.997
 - Right of Appeal Notice – 37 C.F.R. § 1.953
 - Page limits for briefs – 37 C.F.R. § 1.943(c)
 - Appeal procedure – 37 C.F.R. §§ 41.60-41.81
 - See flowcharts in MPEP § 2601.01
 - See also MPEP §§ 2673-2682



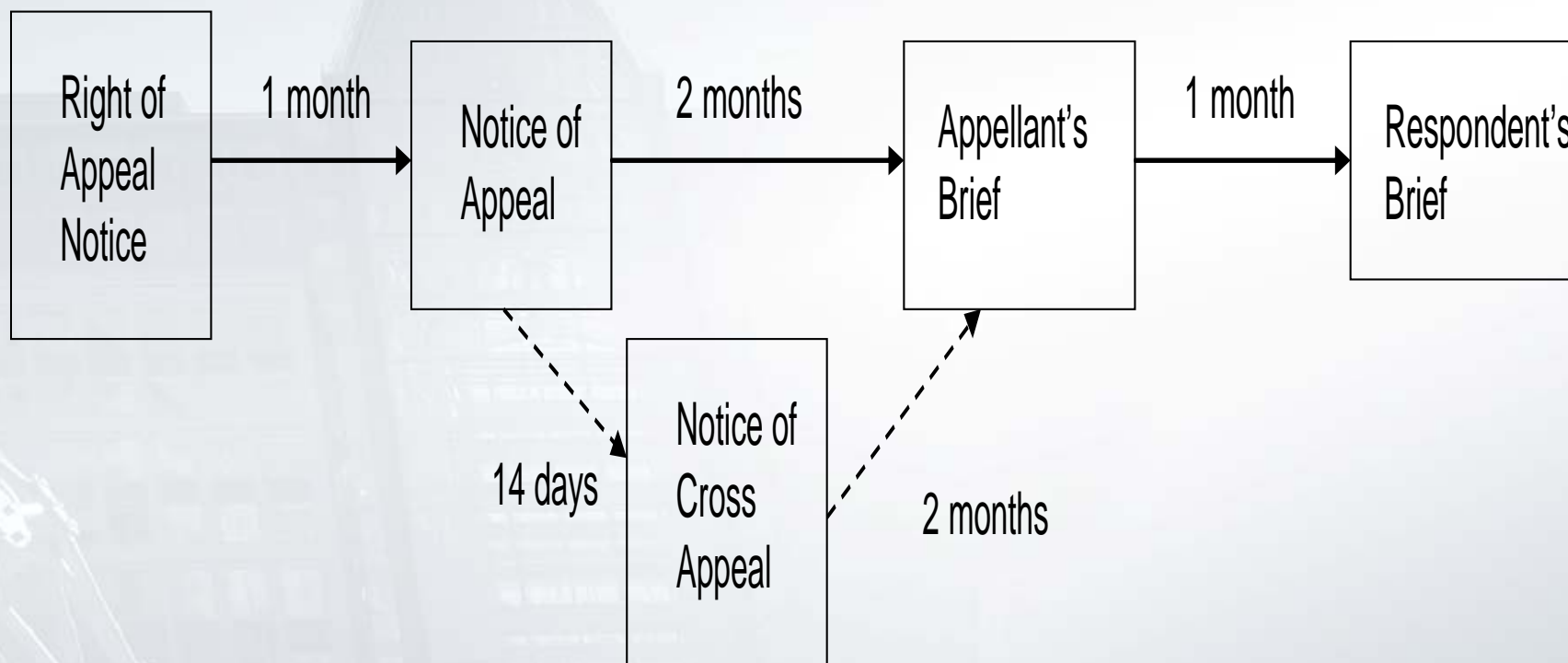
Inter Partes Reexamination Appeals

- Appeal Proceeding
 - Notice of Appeal and Cross Appeal – 37 C.F.R. § 41.61
 - Appellant's Brief – 37 C.F.R. § 41.67
 - Respondent's Brief – 37 C.F.R. § 41.68
 - Examiner's Answer – 37 C.F.R. § 41.69
 - Rebuttal Brief – 37 C.F.R. § 41.71
 - Oral Hearing – 37 C.F.R. § 41.73
 - Decision – 37 C.F.R. § 41.77
 - Rehearing – 37 C.F.R. § 41.79



Inter Partes Reexamination Appeals

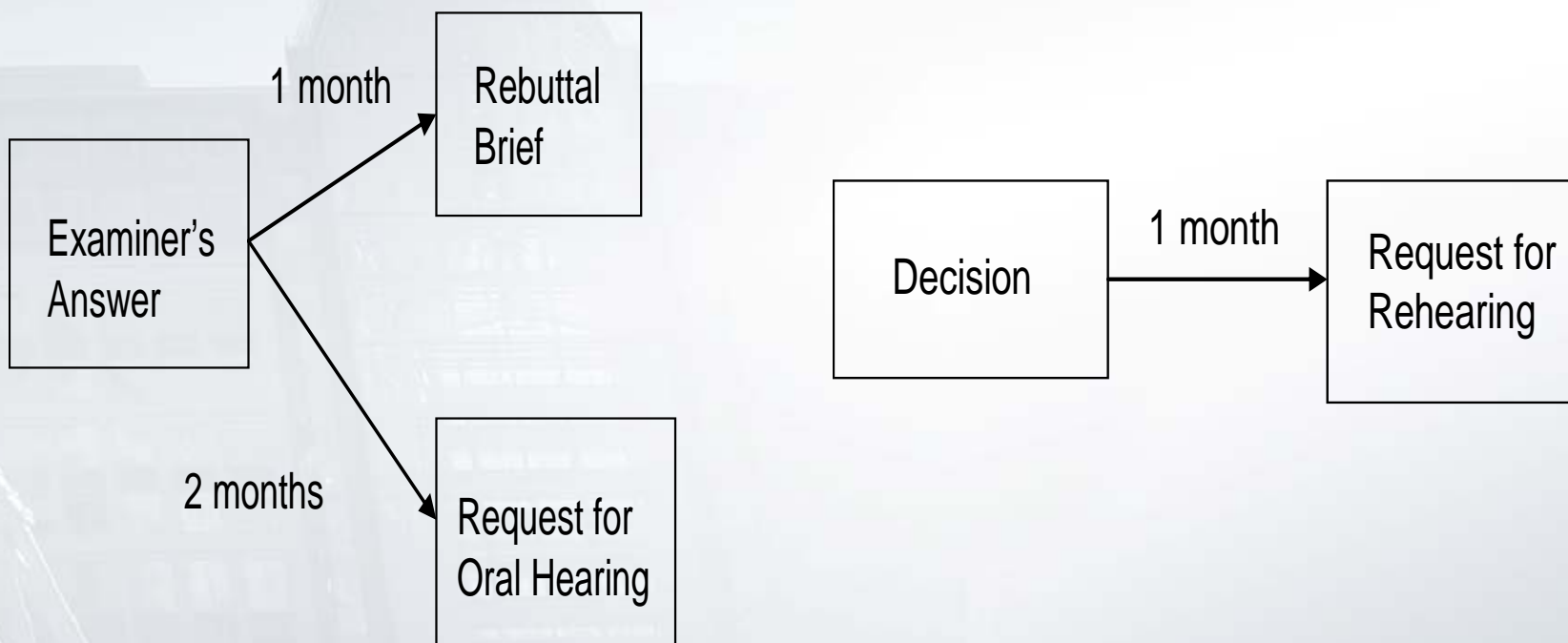
Appeal Timeline





Inter Partes Reexamination Appeals

Appeal Timeline





Inter Partes Reexamination Appeals

Appellant's Brief

- Contents
 - Same as ex parte appeal brief
 - Real party in interest
 - Related appeals and interferences
 - Status of claims
 - Status of amendments
 - Summary of claimed subject matter
 - Issues to be reviewed on appeal
 - Argument
 - Claims appendix
 - Evidence appendix
 - Related proceedings appendix
 - Certificate of service



Inter Partes Reexamination Appeals

Appellant's Brief

- Limitations
 - No new amendment or evidence
 - Page limitation – 30 pages or 14,000 words



Inter Partes Reexamination Appeals

Respondent's Brief

■ Contents

- Real Party in interest
- Related appeals and interferences
- Status of claims
- Status of amendments
- Summary of claimed subject matter
- Issues to be reviewed on appeal
- Argument
- Evidence appendix
- Related proceedings appendix
- Certificate of service



Inter Partes Reexamination Appeals

Respondent's Brief

■ Limitations

- Arguments limited to issues raised in the appellant's brief to which the respondent's brief is directed
- A requester's respondent brief may not address any brief of any other requester
- Page limitation – 15 pages or 7,000 words



Inter Partes Reexamination Appeals

Examiner's Answer

- Contents
 - As may be necessary:
 - Explanation of invention claimed
 - Explanation of references relied upon
 - Grounds of rejection
 - Reasons for patentability
- Limitations
 - No new ground of rejection
 - No new determination not to make a proposed rejection



Inter Partes Reexamination Appeals

Rebuttal Brief

- Contents
 - Patent Owner
 - Arguments directed to issues raised in Examiner's Answer and/or any Respondent Brief
 - Requester
 - Arguments directed to issues raised in Examiner's Answer and/or Respondent Brief of Patent Owner
 - Certificate of service



Inter Partes Reexamination Appeals

Rebuttal Brief

- Limitations
 - Requester
 - No new proposed ground of rejection
 - Arguments not directed to issues raised in the Respondent Brief of any other Requester
 - Page limitation – 15 pages or 7,000 words



Inter Partes Reexamination Appeals

- Frequent Errors
 - Notice of Appeal
 - Claims on appeal not identified
 - Not signed
 - Fee not paid
 - Briefs (Appellant, Respondent and Rebuttal)
 - Page limits exceeded
 - Improper Summary of Claimed Subject Matter – claims not mapped to specification
 - Fee not paid



Inter Partes Reexamination Appeals

Practice Tips for *Inter Partes* Reexamination Appeals



Inter Partes Reexamination Appeals

Practice Tips

- Appellant's Brief – not required but consider providing:
 - Jurisdictional statement
 - Table of contents
 - Table of authorities



Inter Partes Reexamination Appeals

Practice Tips

- Appellant's Brief – arguments should be concise and focused
 - Identify facts in dispute in separate section
 - Identify pivotal claim language and explain resulting claim scope
 - Explain why examiner erred
 - Avoid repetitive and peripheral arguments



Inter Partes Reexamination Appeals

Practice Tips

- Appellant's Brief – arguments directed to why examiner erred
 - *Ex parte Belinne*, Appeal 2009-004693, (BPAI Aug. 10, 2009) (Informative opinion) (“Appellants do not present any arguments to explain why the Examiner's explicit fact finding is in error.”).



Inter Partes Reexamination Appeals

Practice Tips

Appellant's Brief

- Clearly point out **material facts** relevant to why examiner erred
- Clearly point out **claim language** relevant to why examiner erred



Inter Partes Reexamination Appeals

Practice Tips

- Proper claim construction
 - *Ex parte Catlin*, Appeal No. 2007-3072, (BPAI February 3, 2009) (Precedential opinion) (means plus function limitation indefinite where specification fails to disclose algorithm for programming general purpose computer to perform specified function).



Inter Partes Reexamination Appeals

Practice Tips

- KSR considerations
 - *Ex parte Fu*, 89 USPQ2d 1115 (BPAI 2008) (expanded panel) (Precedential opinion) (One skilled in the art would anticipate success in substituting one species for another in its genus where the genus contains a limited number of species.).
 - *Ex parte Whalen*, Appeal No. 2007- 4423, 2008 WL 2957928 (BPAI July 23, 2008) (expanded panel) (Precedential opinion) (“Whalen II”) (A composition with a particular property at a high level is not rendered obvious by a prior art reference that teaches a similar composition and suggests that the property be minimized -- absent some reason to modify.).



Inter Partes Reexamination Appeals

Practice Tips

- *Ex parte Jellá*, 90 USPQ2d 1009 (BPAI 2008)
(expanded panel) (Precedential opinion)
(declaration evidence of non-obviousness)
 - establish nexus between claimed subject matter and evidence
 - evidence should be tied to functional not aesthetic aspects of claimed invention
 - demand established by market share and not solely by gross sales
 - long-felt need established by evidence that need was recognized by those of ordinary skill in the art)



Inter Partes Reexamination Appeals

Practice Tips

- Oral hearing presentation
 - The oral hearing is open to the public.
 - The oral hearing is transcribed by a court reporter and made part of the official record.
 - Make sure you are on time for the hearing. Remember you must clear security.



Inter Partes Reexamination Appeals

Practice Tips

- Oral hearing preparations
 - Identify your best argument in the Appellant's Brief.
 - Do not attempt to present every argument in the brief.
 - Highlight the portions of the specification and the claim language that support your best argument.
 - Identify the portions of the prior art that support your argument that the claim language distinguishes over the prior art.



Inter Partes Reexamination Appeals

Practice Tips

- Oral hearing preparations
 - Identify the weakness of your case.
 - Be prepared to address this weakness directly.
 - Be sure you are making arguments that are made in the Appellant's Brief.



Inter Partes Reexamination Appeals

Practice Tips

- Questions at oral hearing
 - Be prepared
 - Do not view the Judge who is asking the question as an adversary to your appeal.
 - View the question as an opportunity.
 - Do not deny the undeniable - you only lose credibility.



BPAI

Questions?

BPAI website: <http://www.uspto.gov/>

Click on Patents button 7 - "Appeal"

BPAI Phone (571) 272-9797

Phone is staffed every day 8:30 to 4:00

Declaration of the
Honorable Gerald J. Mossinghoff

Exhibit E

PATENT AND TRADEMARK OFFICE
Process Production Report
Preliminary Report

	FY2009 Actual	FY2010 Oct.	FY2010 Nov.	FY2010 Dec.	FY2010 Jan.	FY2010 Feb.	FY2010 Mar.	FY2010 Apr.	FY2010 May	FY2010 Jun.	FY2010 Jul.	FY2010 Aug.	FY2010 Sep.	FY2010 Actual
Board of Patent Appeals and Interferences														
<u>CONTESTED CASES</u>														
Interferences														
Cases Declared														
Monthly		4	7	2	5	4	4	2						
Year-to-date	55	4	11	13	18	22	26	28	28	28	28	28	28	28
Cases Disposed														
Monthly		1	4	5	8	4	7	4						
Year-to-date	63	1	5	10	18	22	29	33	33	33	33	33	33	33
Cases Pending														
Year-to-date	44	47	50	47	44	44	41	39	39	39	39	39	39	39
Ex Parte Reexams Appeals														
Cases Received														
Monthly		5	2	6	18	10	7	22						
Year-to-date	119	5	7	13	31	41	48	70	70	70	70	70	70	70
Cases Disposed														
Monthly		4	11	11	9	8	14	10						
Year-to-date	109	4	15	26	35	43	57	67	67	67	67	67	67	67
Cases Pending														
Year-to-date	65	66	57	52	61	63	56	68	68	68	68	68	68	68
Inter Partes Reexam Appeals														
Cases Received														
Monthly		0	1	7	3	1	1	0						
Year-to-date	15	0	1	8	11	12	13	13	13	13	13	13	13	13
Cases Disposed														
Monthly		0	1	0	4	0	1	2						
Year-to-date	10	0	1	1	5	5	6	8	8	8	8	8	8	8
Cases Pending														
Year-to-date	9	9	9	16	15	16	16	14	14	14	14	14	14	14
<u>EX PARTE APPEALS</u>														
Ex Parte Appeals*														
Cases Received														
Monthly		666	758	733	1042	781	1242	1562	0	0	0	0	0	
Year-to-date	15344	666	1424	2157	3199	3980	5222	6784	6784	6784	6784	6784	6784	6784
Cases Disposed														
Monthly		386	477	495	552	518	810	559	0	0	0	0	0	
Year-to-date	6734	386	863	1358	1910	2428	3238	3797	3797	3797	3797	3797	3797	3797
Cases Pending														
Year-to-date	12507	12787	13068	13306	13796	14059	14491	15494	15494	15494	15494	15494	15494	15494

*Ex parte appeals of applications for patents, not including ex parte reexamination or inter partes reexamination appeals.